



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,951	03/15/2004	Kevin P. Parker	PRKR-4700	4452

7590 11/07/2006

Philip A. Girard  
GIRARD & EQUITZ LLP  
Suite 1110  
400 Montgomery Street  
San Francisco, CA 94104

EXAMINER
----------

OSELE, MARK A

ART UNIT	PAPER NUMBER
----------	--------------

1734

DATE MAILED: 11/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/800,951

Applicant(s)

PARKER ET AL.

Examiner

Mark A. Osele

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 15, 17, 18, 21, 23-27 and 29-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21, 23-27 and 29-34 is/are allowed.
- 6) ☒ Claim(s) 1-8, 17 and 18 is/are rejected.
- 7) ☒ Claim(s) 9-11, 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flood or Groeneweg in view of Parker (2002/0131847) and Voy et al.

Flood shows a cassette for dispensing a plurality of adhesive backed binder strips, L, on an elongated carrier, B, wound into a roll, 2, wherein the cassette comprises a housing, 1, a mounting mechanism, 4, rotatably mounting the binder strip roll, a drive apparatus, 8, for unwinding the binder strip roll to provide an unwound portion, a separating apparatus, 25, within the cassette for separating the binder strips from the carrier to produce a separated binder strip causing the separated binder strip to be at least partially ejected through a binder strip eject opening in the cassette housing (See Figs. 1, 2).

Groeneweg shows a cassette for dispensing a plurality of adhesive backed binder strips, 12, on an elongated carrier, 14, wound into a roll, 32, wherein the cassette comprises a housing, 16, a mounting mechanism, 18, rotatably mounting the binder strip roll, a drive apparatus, 86, for unwinding the binder strip roll to provide an unwound portion, a separating apparatus, 28, within the cassette for separating the binder strips from the carrier to produce a separated binder strip causing the separated binder strip

Art Unit: 1734

to be at least partially ejected through a binder strip eject opening, 26, in the cassette housing (See Fig. 5).

Flood and Groeneweg each fail to show the claimed adhesive pattern on the binder strips.

Voy et al. teaches the use of leading and trailing ends, 117, of an adhesive backed binder on an elongated carrier to be adhesive free (Figs. 3, 5; column 10, lines 3-8, 44-59) so that the binders can be more easily dispensed from the carrier sheet, adhesive will not migrate beyond the periphery of the binder which prevents jamming or clogging of any portion of the apparatus (column 11, lines 26-45), and prevent jamming or fouling of the die cutting assembly which could occur by contact with adhesive. It would have been obvious to one of ordinary skill in the art at the time the invention was made to leave the leading and trailing end of the binder strip of Flood or Groeneweg adhesive free to aid in binder dispensing and to prevent fouling or jamming of cutting or dispensing equipment as taught by Voy et al. In addition, Voy et al. teaches that the adhesive free zone is to be determined by the operator. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the adhesive free zone at the trailing end of the binder strip greater than 20% of the total length of the binder strip because Voy et al. shows this to be a result effective variable under operator control (column 10, lines 49-59).

Parker '847 teaches that binder strips for binding a stack of sheets typically include a heat activated adhesive layer disposed along the length of the binder strip to secure the edges of the sheets to be bound (paragraph 0004). It would have been

Art Unit: 1734

obvious to one of ordinary skill in the art at the time the invention was made to add the heat activated adhesive of Parker '847 to the invention of the references as combined so the binder strips can be used for binding a stack of sheets as taught by Parker '847.

Regarding claim 2, Flood shows the separating apparatus includes a separating member which receives the elongated carrier along a path wherein the input and output portions of the path are at an angle so that the binder strips separate from the carrier when the carrier changes movement from the input to the output path.

Regarding claims 3-4, Flood shows the drive apparatus includes a take up roller, 11, within the housing which receives the elongated carrier after the carrier has passed the separating member and wherein a drive connection, 10, 12, to the take up roller can be rotatably driven by a drive source external to the cassette housing.

Regarding claim 5, Flood shows the cassette further includes a guide mechanism, 22, 23, to guide the unwound portion from the binder strip roll to the separating apparatus along a guide path.

Regarding claim 2, Groeneweg shows the separating apparatus includes a separating member, 76, which receives the elongated carrier along a path wherein the input and output portions of the path are at an angle so that the binder strips separate from the carrier when the carrier changes movement from the input to the output path.

Regarding claims 3-4, Groeneweg shows the drive apparatus includes a take up roller, 24, within the housing which receives the elongated carrier after the carrier has passed the separating member and wherein a drive connection, 25, 90, to the take up roller can be rotatably driven by a drive source external to the cassette housing.

Regarding claim 5, Groeneweg shows the cassette further includes an elongated guide mechanism, 70, 84, to guide the unwound portion from the binder strip roll to the separating apparatus along a guide path.

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Groeneweg or Flood in view of Parker and Voy et al. as applied to claim 5 above and further in view of Carolus et al. Carolus et al. shows a guide mechanism comprising round bar, 5, between the binder strip roll and the separating apparatus. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the bar of Carolus et al. as a guide mechanism in the apparatus of either the references as combined because Carolus et al. teaches that this design achieves braking of the supply reel and tensioning of the unwound portion throughout its path (column 2, lines 37-45).

4. Claims 7-8 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Groeneweg or Flood in view of Parker and Voy et al. as applied to claim 1 above and further in view of Aronson. Aronson teaches an opening, 18, in a cassette housing through which a binder strip roll can be viewed. Parker '847 teaches that optically encoded information on a binder strip can be used to control operation of a device (abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the opening of Aronson and the optically encoded information of Parker '847 to the cassette of the references as combined because

Art Unit: 1734

Aronson shows the advantages of being able to view a strip from the outside of a cassette and Parker '847 teaches that optically encodable information is advantageous on an adhesive backed strip for automation.

Regarding claims 7-8, Aronson further shows an elongated guide which is captured between the binder strip roll and the unwound portion (See Fig. 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to extend the elongated guide of Groeneweg as shown by Aronson because this extension provides control of the unwound portion all the way to its point of departure from the binder strip roll.

***Allowable Subject Matter***

5. Claims 9-11 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 21, 23-27, and 29-34 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art, either alone or in combination, suggests a binder strip roll comprising both binder strips and a carrier wherein the binder strips are not adhered to the carrier. The prior art also fails to suggest an elongate guide member is mounted for movement.

***Response to Arguments***

8. Applicant's arguments with respect to claims 1-8 and 17-18 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

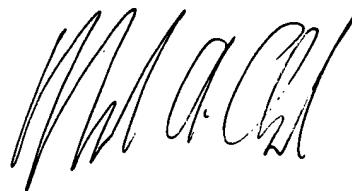
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 1734

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'M. A. Osele', with a stylized, cursive script.

**MARK A. OSELE**  
**PRIMARY EXAMINER**

November 6, 2006